

REMARKS

Claims 1-22 were pending in this application.

Claims 1 and 2 have been rejected.

Claims 3-12 have been objected to.

Claims 13-22 have been allowed.

No claims have been amended.

Claims 1-22 remain pending in this application.

Reconsideration and full allowance of Claims 1-22 are respectfully requested.

I. ALLOWABLE CLAIMS

The Applicants thank the Examiner for the indication that Claims 13-22 are allowable. Claims 13-22 have not been amended and therefore remain in condition for allowance.

The Applicants also thank the Examiner for the indication that Claims 3-12 would be allowable if rewritten in independent form and amended to overcome a rejection under 35 U.S.C. § 112, second paragraph. However, the Applicants respectfully note that the Office Action does not reject any claims under 35 U.S.C. § 112, second paragraph. Also, because the Applicants believe that the remaining claims in this application are allowable, the Applicants have not rewritten Claims 3-12 in independent form.

II. REJECTION UNDER 35 U.S.C. § 102

The Office Action rejects Claims 1 and 2 under 35 U.S.C. § 102(b) as being anticipated

by U.S. Patent No. 4,997,122 to Zimmer (“*Zimmer*”). This rejection is respectfully traversed.

A prior art reference anticipates the claimed invention under 35 U.S.C. § 102 only if every element of a claimed invention is identically shown in that single reference, arranged as they are in the claims. (*MPEP* § 2131; *In re Bond*, 910 F.2d 831, 832, 15 U.S.P.Q.2d 1566, 1567 (Fed. Cir. 1990)). Anticipation is only shown where each and every limitation of the claimed invention is found in a single prior art reference. (*MPEP* § 2131; *In re Donohue*, 766 F.2d 531, 534, 226 U.S.P.Q. 619, 621 (Fed. Cir. 1985)).

Zimmer recites a process for shaping solder on a substrate. (*Abstract*). A tool is brought into contact with the solder and heated, thereby melting and shaping the solder. (*Abstract*). The tool is then cooled so the solder may resolidify, and the tool is withdrawn from the solidified solder. (*Abstract*).

Zimmer simply recites that a tool is heated and used to shape solder. *Zimmer* lacks any mention of aligning the tool with one or more holes in the substrate. As a result, *Zimmer* fails to anticipate a “stamping tool” that is capable of “aligning a position of [a] stamp with respect to at least one tooling hole in [an] integrated circuit substrate” as recited in Claim 1.

The Office Action asserts that these recitations in Claim 1 are “recitations of intended use” and that the “tooling of *Zimmer* is capable of alignment by any means.” (*Office Action*, Page 2, Section 2). If a “prior art structure is capable of performing [an] intended use, then it meets the claim.” (*MPEP* § 2111.02). The Office Action has not shown that *Zimmer* is capable of aligning a “stamp” using “at least one tooling hole in [an] integrated circuit substrate” as recited in Claim 1. In fact, *Zimmer* fails to recite any mechanism for aligning a stamp.

Moreover, the Office Action has not established that alignment of a stamp using “at least one tooling hole” was known in the art before the filing date of this application. As a result, the Office Action has not established that *Zimmer* is capable of alignment using the mechanism recited in Claim 1.

For these reasons, *Zimmer* fails to anticipate the Applicants’ invention as recited in Claim 1 (and Claim 2 depending from Claim 1). Accordingly, the Applicants respectfully request withdrawal of the § 102 rejection and full allowance of Claims 1 and 2.

III CONCLUSION

As a result of the foregoing, the Applicants assert that all pending claims in the application are in condition for allowance and respectfully request an early allowance of such claims.

SUMMARY

If any outstanding issues remain, or if the Examiner has any further suggestions for expediting allowance of this application, the Applicants respectfully invite the Examiner to contact the undersigned at the telephone number indicated below or at *wmunck@davismunck.com*.

The Commissioner is hereby authorized to charge any additional fees connected with this communication (including any extension of time fees) or credit any overpayment to Davis Munck Deposit Account No. 50-0208.

Respectfully submitted,

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